

**REMARKS/ARGUMENTS**

This Amendment is responsive to the Office Action mailed on November 9, 2010.

In this Amendment, claims 21, 32, and 45 are amended, and claims 49-52 are added. Claims 1-20, 33 and 38 were previously cancelled. Thus, claims 21-32, 34-37, and 39-52 are pending and subject to examination upon entry of this Amendment. The amendments and new claims do not add new matter. Entry of this Amendment is respectfully requested.

On page 2 of the Office Action, claim 45 is rejected under 35 USC 112 on the basis that there is insufficient antecedent basis for the limitation “the special program.” Also on page 2 of the Office Action, claims 21-23, 25, 26, 28, 29, 32, 35, 36, 39, 41-44, and 46-48 are rejected under 35 USC 103(a) as being unpatentable over Fowler (US Patent Publication 2002/0026348) in view of Fernandez (US Patent Publication 2001/0016827). On page 7 of the Office Action, claim 24 is rejected under 35 USC 103(a) as being unpatentable over Fowler in view of Ryan (US Patent Publication 2005/0055272). Also on page 7 of the Office Action, claims 27, 34, 37 and 45 are rejected under 35 USC 103(a) as being unpatentable over Fowler in view of Nerger Monkia “Evening the odds: CRM systems are driving sophisticated loyalty programs at Las Vegas Casinos – and not just for the high rollers,” March 1, 2002. On page 9 of the Office Action, claims 30, 31, and 40 are rejected under 35 USC 103(a) as being unpatentable over Fowler in view of Postrel (US Patent 6,594,640). These rejections are respectfully traversed.

**Claim rejections under 35 USC §112**

Claim 45 has been amended to depend from claim 27 rather than claim 28. Claim 27 provides antecedent basis for “the special program” recited in claim 28. Thus, Applicants respectfully request withdrawal of this outstanding rejection.

**Claim rejections under 35 USC §103(a)**

Claims 21-23, 25, 26, 28, 29, 32, 35, 36, 39, 41-44, and 46-48

First, claim 21 as amended recites, *inter alia*, “providing for a combination reward program ... wherein the combination reward program is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.” For example, although not so limited by the claims, as described with reference to FIG. 7 of the subject application, if a consumer purchases bleach W from one merchant, they will be issued an award of \$0.50, and if a consumer purchases dryer sheet Y from another merchant, they will be issued an award of \$0.50, so that typically if a consumer were to purchase one bleach W and two dryer sheets Y they will be issued an award of \$1.50. However, as described with reference to FIG. 7, if a consumer purchases bleach W from one merchant and two dryer sheets Y from another merchant, instead of only being issued an award of \$1.50, they will be issued an additional reward of \$0.50, bringing the total reward to \$2.00. The relied upon references fail to teach or suggest at least the aforementioned claim features.

Fowler discloses a real-time, automated marketing program implementing one or more program rules matrix modules that calculate benefits to customers based on one or more customer identifier(s), one or more merchant identifier(s) and one or more customer behavior(s). (Fowler, abstract). Fowler also discloses an Award Accelerator Program (AAP) in which successive qualifying behaviors of specified qualifying users at one or more qualifying merchants produces successively different (e.g., increasing or decreasing) awards. (Fowler, paragraph [0028]). Fowler also discloses that merchant groups, such as a chain of stores, or merchants located in a certain geographical area or distributing certain types of goods, may apply a custom set of rules that unites the merchants in a coordinates marketing program. (Fowler, paragraph [0031]). However, Fowler fails to teach or suggest “providing for a combination reward program ... wherein the combination reward program is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at

a second location” since Fowler’s device does not add awards onto pre-existing awards on the condition that a consumer purchase multiple products at multiple merchants.

The Office Action suggests that such features are disclosed in paragraphs [0026]-[0031] and [0083] of Fowler. (Office Action dated November 9, 2010, page 3). Applicants respectfully disagree for the following reasons.

Paragraph [0026] discloses program matrix rules module(s) specifying one or more qualifying customer identifier(s), one or more qualifying merchant identifier(s), one or more qualifying customer behavior(s), which predetermine awards based on a combination of customer identifier(s), merchant identifier(s), behavior(s), etc. However, the general disclosure of a program matrix rules module is simply too broad of a disclosure to teach or suggest providing a combination reward in addition to a first and second award. Moreover, the program matrix rules module is disclosed in the context of a single automated marketing program, whereas claim 1 recites not only first and second reward programs providing first and second rewards, but the provision of a combination reward in addition to the first and second awards.

Paragraph [0027] discloses a custom-tailored program matrix rules modules for individual merchants and merchant groups. However, even if each merchant or merchant group has a custom-tailored program matrix rules module, corresponding, e.g., to each of the first and second reward programs, there is no disclosure of a combination reward which is provided in addition to the rewards from the first and second reward programs.

Paragraph [0028] discloses that merchants may implement AAPs, in which each successive award over a timer period may be increased or decreased. However, in an AAP, a single award is provided for a single purchase (although that award may be increased or decreased). AAP does not refer to providing awards in addition to a single given award.

Paragraph [0029] discloses that qualifying behavior(s) may be any action on the part of a user that satisfies criteria established by the merchant(s) and implemented in a program rules matrix module. However, similar to paragraph [0026], the disclosure of “qualifying behavior(s)” is simply too broad to teach or suggest providing a combination reward in addition to a first and second award. Moreover, the program matrix rules module is disclosed in the context of a single automated marketing program, whereas claim 1 recites not only first and

second reward programs providing first and second rewards, but the provision of a combination reward in addition to the first and second awards.

Paragraph [0030] provides an example of an AAP. However, similar to paragraph [0028], in an AAP a single award is provided for a single purchase. AAP does not refer to providing awards in addition to a single given award.

Paragraph [0031] discloses that the marketing methods and systems allow customers to earn accelerated benefits. However, similar to paragraph [0028], accelerated benefits refers to providing a single award for a single purchase – not providing awards in addition to a single given award.

Paragraph [0083] discloses a combination card having AAPs and/or other marketing programs associated with it. However, associating AAPs with a combination card does not lead to the provision of a combination reward in addition to first and second awards.

For at least these reasons, Fowler fails to teach or suggest the aforementioned features of claim 21. The other relied upon references fail to cure the deficiencies of Fowler. Accordingly, claim 21 is allowable over the disclosure of the relied upon references. Claims 22, 23, 25, 26, 28, 29, 42-44, and 46-48 depend from claim 21, and thus are allowable over the relied upon references for at least the same reasons as claim 21, as well as on their own merits. Further, independent claim 32 recites similar limitations, and is thus allowable for reasons similar to those discussed above for claim 21. Claims 35, 36, 39, and 41 depend from claim 32, and thus are allowable over the relied upon references for at least the same reasons as claim 32, as well as on their own merits.

Second, claim 21 as amended recites, *inter alia*, “wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer.” The relied upon references fail to teach or suggest the aforementioned claim features.

Fowler discloses the use of “combo-cards” which may have conventional credit or debit accounts associated with them, as well as one or more marketing programs and/or Award Accelerator Programs. The Combo-cards may include cards having an embedded electronic

microchip, such as a contact or contactless Smart Card. (Fowler, paragraph [0083]). However, although Fowler discusses the general use of associating a marketing program with a Smart Card, there is no disclosure in Fowler that the Smart Card includes a dynamic data field which may be updated based on a product preference of a consumer.

The other relied upon references fail to cure the deficiencies of Fowler. For example, although Postrel discloses accumulating reward points on a smart card (Postrel, col. 9, lines 55 to 67), Postrel also does not disclose that the smart card includes a dynamic data field which may be updated based on a product preference of a consumer.

For at least these reasons, the relied upon references fail to teach or suggest the aforementioned features of claim 21. Accordingly, claim 21 is allowable over the disclosure of the relied upon references. Claims 22, 23, 25, 26, 28, 29, 42-44, and 46-48 depend from claim 21, and thus are allowable over the relied upon references for at least the same reasons as claim 21, as well as on their own merits. Further, independent claim 32 recites similar limitations, and is thus allowable for reasons similar to those discussed above for claim 21. Claims 35, 36, 39, and 41 depend from claim 32, and thus are allowable over the relied upon references for at least the same reasons as claim 32, as well as on their own merits.

#### Claim 24

Claim 24 depends from claim 21, and the rejection to claim 24 relies on Fowler teaching features of claim 21 such as “providing for a combination reward program ... wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.” However, as discussed above, Fowler fails to teach or suggest these features. Ryan and the other relied upon references fail to cure the deficiencies of Fowler. For at least these reasons, claim 24 is allowable over the disclosure of the relied upon references.

Claims 27, 34, 37, and 45

Claims 27 and 45 depend from claim 21, and the rejection to claims 27 and 45 relies on Fowler teaching features of claim 21 such as “providing for a combination reward program ... wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.” However, as discussed above, Fowler fails to teach or suggest these features. Nerger Monkia and the other relied upon references fail to cure the deficiencies of Fowler. For at least these reasons, claims 27 and 45 are allowable over the disclosure of the relied upon references.

Claims 34 and 37 depend from claim 32, and the rejection to claims 34 and 37 relies on Fowler teaching features of claim 32 such as “providing for a combination reward program ... wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.” However, as discussed above, Fowler fails to teach or suggest these features. Nerger Monkia and the other relied upon references fail to cure the deficiencies of Fowler. For at least these reasons, claims 34 and 37 are allowable over the disclosure of the relied upon references.

Claims 30, 31, and 40

Claims 30 and 31 depend from claim 21, and the rejection to claims 30 and 31 relies on Fowler teaching features of claim 21 such as “providing for a combination reward program ... wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.” However, as discussed above, Fowler fails to teach or suggest these features. Postrel

and the other relied upon references fail to cure the deficiencies of Fowler. For at least these reasons, claims 30 and 31 are allowable over the disclosure of the relied upon references.

Claim 40 depends from claim 32, and the rejection to claim 40 relies on Fowler teaching features of claim 32 such as “providing for a combination reward program ... wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.” However, as discussed above, Fowler fails to teach or suggest these features. Postrel and the other relied upon references fail to cure the deficiencies of Fowler. For at least these reasons, claim 40 is allowable over the disclosure of the relied upon references.

#### Expediting Prosecution

Applicants note that the Office Action’s use of broad citations to the prior art (e.g., “see paragraph 26-31” on page 3 of the outstanding Office Action) makes it particularly difficult for Applicants to identify which specific features of the prior art Examiner considers to render obvious the individual claim elements recited in Applicants claims. Accordingly, Applicant respectfully requests that, if further prosecution is deemed necessary, the Office Action particularly point out the relevant teachings of the prior art relied upon. See, e.g., MPEP 706.02(j)(“After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate...”).

#### **Rejections to Claims 30-31 Under 35 U.S.C. § 103 in View of Official Notice**

In the Office Action, claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler in view of Postrel in view of Official Notice. This rejection is traversed.

Pursuant to MPEP 2144.03, Applicants challenge the Examiner’s taking of Official Notice in each and every instance that this is done in this Office Action. Unless a specific piece of prior art is cited to meet the claim limitations, Applicants cannot determine if

the Examiner has satisfied the burden of establishing obviousness. For example, even if the Examiner can find a reference teaching "smarts cards that conform[s] to ISO standard 7816" (see discussion in Office Action at paragraph 8 relating to claims 30 and 31) the reference may not be combinable with the other cited references or may teach away from the combination. Thus, Applicants respectfully request that the Examiner find a prior art reference to support each allegation that a feature that is present in the claims is "well known."

### **New claims 49-52**

New claims 49-50 properly depend from claim 21, and thus are allowable for the same reasons as claim 21. Further, claims 49-50 are allowable on their own merits. For example, with respect to claim 49, none of the relied upon references teach or suggest customizing future reward redemption and accumulation based on the product preference of the consumer.

Similarly, new claims 51-52 properly depend from claim 32, and thus are allowable for the same reasons as claim 32. Further, claims 51-52 are allowable on their own merits. For example, with respect to claim 51, none of the relied upon references teach or suggest customizing future reward redemption and accumulation based on the product preference of the consumer.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.



Appl. No. 10/676,382  
Amdt. dated March 7, 2011  
Reply to Office Action of November 9, 2010

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at .

Respectfully submitted,

/Patrick R. Jewik/

Patrick R. Jewik  
Reg. No. 40,456

KILPATRICK TOWNSEND & STOCKTON LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
PRJ/BDR:djb  
63151678 v1